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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/924,961	08/08/2001	Carl M. Hoffmaster	05516.089001	1995

22511 7590 05/09/2003

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EXAMINER

DANG, HOANG C

ART UNIT

PAPER NUMBER

3672

DATE MAILED: 05/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

09/924,961

Applicant(s)

HOFFMASTER ET AL.

Examiner

Hoang Dang

Art Unit

3672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 February 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-200 is/are pending in the application.
- 4a) Of the above claim(s) 1-131 and 151-200 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 132-150 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 January 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 & 6. 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election without traverse of Group X, claims 132-150 in Paper No. 8 is acknowledged.
2. Claims 1-131 and 151-200 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 8.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 132, 133, 134, 135, 139, 140, 143, 145, 146, 148, 149 and 150 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGarian et al (US 5,853,054) in view of Mensa-Wilmot et al (US 6,507,025).

McGarian et al discloses the invention as claimed (see figures 1, 2, 5-9 and column 5, line 51 through column 7, line 17) except for the "redundant" cutters. It appears from figures 1, 2 and 5-9 of McGarian et al that at least some redundant cutting do occur due to the symmetrically arrangement of the cutter blades 6A and 6B and numerous cutting elements provided on these blades. In any event, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide McGarian et al with "redundant cutters" as claimed in view of the

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teaching of Mensa-Wilmot et al in order to increase the durability and life of the drill bit (see column 12, lines 6-29).

As for claim 143, it would have been obvious to use cutting elements having the size I in the claimed range since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

As for claims 145, 146 and 149, it would have been obvious to use the material as claimed since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

5. Claims 136 and 147 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGarian et al in view of Mensa-Wilmot et al '025 as applied to claim 132 above, and further in view of Hansen et al (US 5,979,576) or Griffin et al (US 6,142,250).

McGarian et al as modified by Mensa-Wilmot et al discloses the invention as claimed except for the presence of a "vibration damping insert". However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide McGarian et al as modified by Mensa-Wilmot et al with a vibration damping insert as claimed because it is well known in the well drilling art to provide such an insert to enhance the stability of the drill bit or to minimize bit whirl as evidenced by Hansen et al (see column 6, lines 19-26) or Griffin et al (see column 5, lines 41-51).

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As for claim 147, it is conventional in the art to mount cutting elements such that the cutting element exposure is more than half of a diameter of the cutting element as evidenced by either Hansen et al or Griffin et al.(see cutting elements in the drawings of these patents)

6. Claims 137, 138 and 144 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGarian et al in view of Mensa-Wilmot et al '025 as applied to claim 132 above, and further in view of Beaton et al (US 6,269,893) or Huang et al (US 6,516,293).

McGarian et al as modified by Mensa-Wilmot et al discloses the invention as claimed except that the cutting elements are not disclosed as being arranged such that the axial force, lateral force or mass is balanced. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to arrange cutting elements of McGarian et al as modified by Mensa-Wilmot et al so as to have the axial forces, lateral forces and mass balanced as claimed in view of the teaching of Beaton et al (see column 5, line 32 through column 6, line 10) or Huang et al (see column 13, lines 51-61) in order to improve drilling stability or/and drilling performance.

7. Claims 141 and 142 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGarian et al in view of Mensa-Wilmot et al '025 as applied to claim 132 above, and further in view of Mensa-Wilmot et al (US 6,164,394).

McGarian et al as modified by Mensa-Wilmot et al '025 disclose the invention as claimed except for the recited range of the backrake angles. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the angles in the claimed range or use cutting elements having different backrake angles because Mensa-Wilmot et al '394

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teach using cutting elements having different backrake angles and using backrake angles within the claimed range to enhance drilling performance (see column 10, lines 34-35).

***Conclusion***

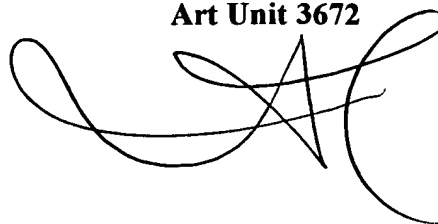
8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoang Dang whose telephone number is 703-308-2149. The examiner can normally be reached on 9:15-5:45 Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Bagnell can be reached on 703-308-2151. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3597 for regular communications and 703-305-3597 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2168.

**Hoang Dang  
Primary Examiner  
Art Unit 3672**



09924961.1rej  
May 3, 2003